



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/343,686	11/21/94	KELLER	G 287926

SHERIDAN ROSS AND MCINTOSH
1700 LINCOLN STREET
SUITE 3500
DENVER CO 80203

18M2/0402

LAFS EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

1808

DATE MAILED:

04/02/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/343,686

Applicant(s)
Gordon M. Keller et al.

Examiner
Kristin K. Larson

Group Art Unit
1808



☒ Responsive to communication(s) filed on Aug 28, 1995

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-107 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-107 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-12, drawn to an embryoid body cell population, classified in Class 424, subclass 582, for example.

Group II. Claims 13-26, drawn to a method to produce a cell type, classified in Class 435, subclass 240.2, for example.

Group III. Claims 27-59, drawn to an embryonic blast cell population and a method for obtaining a population comprising embryonic blast cells, classified in Class 435, subclass 240.1, for example.

Group IV. Claims 60-72, drawn to a mixed population of endothelial cells and erythroid cells and a method to produce a mixed population of endothelial and erythroid cells, classified in Class 424, subclass 93.7, for example.

Group V. Claims 73-79, drawn to a BLAST-LYM cell population, classified in Class 424, subclass 582, for example.

Group VI. Claims 80-83, drawn to a method for obtaining a BLAST-LYM cell population, classified in Class 435, subclass 240.1, for example.

Group VII. Claims 84-85, drawn to a lymphoid cell population, classified in Class 435, subclass 240.1, for example.

Group VIII. Claims 86-96, drawn to a BLAST-NEM cell population and a method for obtaining a BLAST-NEM cell population, classified in Class 435, subclass 240.1, for example.

Group IX. Claims 97-106, drawn to a method to identify a compound expressed during the development of a population of embryonic blast cells, classified in Class 435, subclass 41, for example.

Group X. Claim 107, drawn to a formulation comprising culture medium, classified in Class 435, subclass 240.3, for example.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II, III, and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the product of Group I can be used as a tissue implant. Further, as illustrated by Groups II, III, and IV, the product of Group I has a variety of uses.
3. Inventions III and V, VI, VII, and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the product of Group III can be used to make a BLAST-LYM cell population, a lymphoid cell population, or a BLAST-NEM cell population. The claims illustrate the fact that the product of Group III has a number of different uses.
4. Inventions IV and VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can

be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case, the product as claimed can be made by culturing the cell population in a fetal thymic culture or cultured with bone marrow stromal cells.

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive **particularly with regard to the literature search**. Further, in view of the different ingredients and method steps required to practice each invention, a reference which would anticipate the invention of any one group would not necessarily anticipate or even make obvious any other group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Serial Number: 08/343,686
Art Unit: 1808

-5-

application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).


Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristin Larson, whose telephone number is 703-305-7811. The fax number for Art Unit 1808 is 703-305-7401. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is 703-308-0196.

15L

Kristin K. Larson
April 1, 1996


MICHAEL G. WITYSHYN
SUPERVISORY PATENT EXAMINER
GROUP 1800
4-1